



Atty. Dkt. 28952.5481

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/072,429

Confirmation No.: 2615

In re Application of:

Jacques FAGOT et al.

Group Art Unit: 3711

Filed: March 7, 2002

Examiner: Stephen Luther Blau

For: SET OF GOLF CLUBS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request accompanies Appellants' Notice of Appeal.

Claims 1, 7, 8, 11, 12, 15 and 16 are pending, and all rejections thereof have been appealed. A copy of independent claim 1 is attached hereto.

The claims were rejected under §103(a) over Peters USP 6,093,112 in view of Besnard USP 5,643,112. But the Office Action improperly subsumed appellants' claimed invention into the prior art.

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While Besnard discloses one or more recesses opening through the rear face of the upper wall (of perimeter weighting in a golf club head), Besnard does not disclose or suggest varying such recesses from one club to another within a set to thereby vary the location of the center of gravity of the club heads from one club to another in such a set.

Peters discloses two clubs in a pair, each of which is made from incomplete club head parts which during production temporarily have a recess in the rear surface of a lower wall, which recess during production is filled with a material more dense than the material of the incomplete club head part, thereby producing a completed club head which has no such recesses. Peters does disclose that inclusion of such more dense material in the lower wall moves the club head center of gravity downward. But Peters does not disclose varying the higher density weighting from club to club within a set of such clubs.

Appellants note the admissions in the Office Action as reviewed at pages 8 and 12 of the Amendment filed February 16, 2005, and the improper assumptions in the Office Action,

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reviewed at pages 9 and 14 of that Amendment. The Office Action improperly subsumed appellants' claimed invention into the prior art.

There is no disclosure in Peters of a complete golf club head having any unfilled recess in the rear face of even a lower wall, let alone an upper wall as recited in appellants' present claims. In Peters, any such recess is present only in an incomplete club head. In Peters' complete club heads the recessed region of an incomplete club head is filled with an even more dense material than the remainder of the complete club head. This is the utter opposite of the structure of appellants' dependent claims 7 and 15 "wherein the recess [in the upper wall, not a lower wall] is filled with a low-density material." Peters teaches diametrically away from appellants' claimed structure.

Although Peters generally raises vertical positions of the centers of gravity from a number 1 iron to a pitching wedge (column 15, lines 40 and 41), Peters does not teach or suggest that this is accomplished by varying a volume of at least one recess in the upper wall of the club head from one iron to

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another within the set. Peters discloses only that weight inserts 174 and 176 or 178 are provided in the lower wall of club heads making up only a specific two-club group of irons (second group 158) within the set as a whole. Peters does not teach complete club heads having a recess (especially no recess in the upper wall of a complete club head). Peters attaches dense inserts to form the complete club head; there is no opening or cavity in the complete club head at the locations where such inserts are attached.

The use of weight inserts in the lower wall in Peters teaches away from the use of recesses in the upper wall as recited in appellants' claim 1. The use of inserts in golf club heads is the opposite of using recesses; the inserts add material and thus weight to a club head, while recesses omit material and thereby remove weight from the club head. Thus, there would be no suggestion or motivation for one skilled in the art to add a recess as in Besnard to the club head of Peters since Peters teaches diametrically away from the use of recesses by instead adding inserts to his club heads. Adding dense

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weight to one portion of a club head does not teach removing weight from a different part of the same club head.

For at least the foregoing reasons, all of appellants' claims 1, 7, 8, 11, 12, 15 and 16 are non-obvious and patentable over the disclosures of the Besnard and Peters references. Review and withdrawal of all rejections are respectfully requested.

Respectfully submitted,

STEPTOE & JOHNSON LLP

A handwritten signature in black ink, appearing to read "Roger W. Parkhurst", with a stylized flourish at the end.

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September 28, 2005

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CLAIM 1

1. A set of golf club irons, each iron of said set having a head, said head having a rear face, said rear face having a cavity bounded by a plurality of walls, wherein said plurality of walls comprises at least one lower wall forming a sole and an upper wall, said upper wall having a plurality of faces, said plurality of faces comprising a rear face, an upper face, a lower face facing the cavity and a plurality of lateral faces, wherein said head comprises at least one recess in the upper wall and said at least one recess opens onto the rear face of said upper wall, the recess being elongate in the main direction of the upper wall, and wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set, to cause the center of gravity of each head to vary in distance relative to said upper face from one iron to another.